

**REMARKS**

**I. Introduction**

This paper is filed in response to the final Office Action mailed February 19, 2010.

Claims 1-6, 8, 10-14, and 16-17 are currently pending in this application. Claims 1-6, 8, 10-14, and 16-17 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Reconsideration is requested in light of the remarks below.

**II. Claims 1-6, 8, 10-14, 16-17 - 35 U.S.C. § 101**

Applicant respectfully traverses the rejection of claims 1-6, 8, 10-14, and 16-17 under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Whoever invents or discovers any new and useful process... or any new and useful improvement thereof, may obtain a patent therefor.” 35 U.S.C. § 101. “[T]he machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible “process.” ” *Bilski v. Kappos*, 561 U.S. \_\_\_, 8 (2010). “[T]he Patent Act leaves open the possibility that there are at least some processes that can be fairly described as business methods that are within patentable subject matter under § 101.” *Id.* at 12. Claims which recite a computerized method which includes a step of outputting information from a computer are tied to a particular machine or apparatus. *Ex Parte Dickerson*, (BPAI July 9, 2009).

Because the Examiner exclusively relied on the machine-or-transformation test for determining that claims 1-6, 8, 10-14, and 16-17 were not a patent-eligible process, the Examiner’s rejection is moot. On page 14 of the Office Action, the Examiner argues that “method claims must meet a specialized, limited meaning to qualify as a patent-eligible process claim,” and that the claimed invention is directed to non-statutory subject matter because “[t]he

claimed invention fails to pass the machine-or-transformation test.” However the Supreme Court recently over-ruled that test as being exclusive for determining patent-eligible subject matter, holding that “the machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible “process”.” See *Bilski v. Kappos*, 561 U.S. \_\_\_, 8 (2010). Therefore the Examiner’s rejection based on an exclusive reliance on the machine-or-transformation test to determine the eligibility of the claims is moot.

Furthermore, because claims 1-6, 8, 10-14, and 16-17 are directed to a concrete process for calculating a value position of a buyer and not an attempt to patent an abstract idea, claims 1-6, 8, 10-14, and 16-17 are patentable subject matter. Methods and systems according to the invention assign value positions to buying organizations, which are used to frame a response to the buying organization. See Specification, paragraph 0007. The claimed methods and systems “do not attempt to patent a mathematical formula,” or “explain a fundamental economic practice long prevalent in our system of commerce and taught in any introductory class.” On the contrary, the claims recite novel and inventive systems and methods for calculating a value position of a buying organization. See *Bilski v. Kappos*, 561 U.S. \_\_\_, 15 (2010). Thus claims 1-6, 8, 10-14, and 16-17 are patent-eligible subject matter.

Finally, unlike the claims in *Bilski*, which did not recite a specific or even a general machine, claims 1-6, 8, 10-14, and 16-17 recite either a computerized method or a system comprising a computer. Specifically, independent claims 1 and 8 are computerized methods which output information from a computer, independent claims 13 and 14 are system claims including a computer performing significant ‘solution activity’ elements, and independent claim 16 recites a computer-readable medium with program code for performing certain steps. Thus, even under the machine-or-transformation test, claims 1, 8, 13, 14, and 16, from which claims 2-

6, 10-12, and 17 depend and further limit, are tied to a machine and produce a useful, concrete, and tangible result," e.g. a framed response (claim 1) or a value position (claims 8, 13, 14, and 16).


Applicant respectfully requests the Examiner withdraw the rejection of claims 1-6, 8, 10-14, and 16-17 under 35 U.S.C. § 101.

**CONCLUSION**

In light of the amendments and remarks herein, Applicant respectfully requests allowance of all pending claims. A fee for a three month extension of time is due with this application. It is believed that no other fees are due with this submission. Should that determination be incorrect, then please debit Account No. 50-0548 and notify the undersigned.

Respectfully submitted,

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